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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,992	12/10/2003	David Myatt Parker	C70259D2	9412

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EXAMINER

HENLEY III, RAYMOND J

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 06/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/733,992	Applicant(s) PARKER, DAVID MYATT	
	Examiner Raymond J Henley III	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/125,471.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

CLAIMS 1-22 ARE PRESENTED FOR EXAMINATION

Applicant's Preliminary Amendment filed December 10, 2003 has been received and entered into the application. Accordingly, an abstract has been added and the specification at page 1 as well as claims 3-10, 12 and 14-19 have been amended.

Completed copies of forms PTO-1449 filed in USSN 09/978,993 have also been included with this Office action reflecting the fact that the references cited thereon have been considered by the Examiner in the instant matter.

Specification

The disclosure is objected to because of the following informality:

In the amended section at page 1 of the specification, USSN 09/978,993 should be updated to show its current status as U.S. Patent No. 6,719,963 and USSN 09/125,471 should be updated to show its current status as U.S. Patent No. 6,319,490. Also, at the last line of the amendment, after "1998", ---, which is a 371 of PCT/EP97/00646 filed 12 February 1997 should be inserted.

Appropriate correction is required.

Claim Rejection - 35 USC § 112, Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 14, there lacks a step whereby the objective of using calcium as a tooth erosion inhibitor is accomplished, i.e., no step of contacting the teeth is set forth.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Obviousness-type Provisional

Claims 1-13, 19 and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13, 22 and 27 of co-pending U.S. Application No. 10/051,846. Although the conflicting claims are not identical, they are not patentably distinct from each other because liquid composition of the type presently claimed, i.e., fruit drinks are routinely formulated as a dry powdered composition in order to facilitate consumer use, manufacturing and distribution of the product.

This is a provisional rejection because the co-pending claims have not been patented.

Obviousness-type, Non-provisional

I Claims 14-18, 21 and 22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 6,319,490.

Although the conflicting claims are not identical, they are not patentably distinct from each other

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because the methods of the '490 patent are directed to the same step of the same method, namely of adding 0.3 to 0.55 mol of calcium per mole of acid to the same acidic liquid oral composition, beverage, fruit, health or carbonated soft drink or to its concentrate.

II Claims 1-13, 19 and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 6,319,490.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '490 patent are directed to compositions and methods for their preparation which compositions contain 0.3 to 0.55 mol of calcium per mole of acid to the same acidic liquid oral composition. The selection of the specific calcium or acid source from those known to be orally acceptable would have been a matter well within the purview of the skilled artisan.

III Claims 14-18, 21 and 22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,319,490.

Although the conflicting claims are not identical, they are not patentably distinct from each other because liquid composition of the type presently claimed, i.e., fruit drinks are routinely formulated as a dry powdered composition in order to facilitate consumer use, manufacturing and distribution of the product.


Accordingly, for the above reasons, the claims are deemed properly rejected and none are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J Henley III whose telephone number is 571-272-0575. The examiner can normally be reached on M-F, 8:30 am to 4:00 pm Eastern Time.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on 571-272-0584. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Raymond J Henley III
Primary Examiner
Art Unit 1614

June 1, 2004